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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,342	04/20/2004	Norman Yamamoto	AVERY-68520 (3318-US)	6797

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EXAMINER
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ADDISU, SARA

ART UNIT	PAPER NUMBER
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3722

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09/13/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/829,342	Applicant(s) YAMAMOTO ET AL.	
	Examiner Sara Addisu	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 17, 18 and 22-25 is/are rejected.
- 7) ☒ Claim(s) 13-16, 19-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED OFFICE ACTION

This Office Action is in response to the amendment filed 3/6/07. New claims 23-25 have been added. Currently, claims 1-25 are pending in this application.

#### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1, 2, 4-6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,764,242 (Karten et al) in view of Abbott (6,017,164) and further in view of Arakaki (4,828,421).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the Karten et al reference does disclose a binder having a front cover with a transparent window inset into the cover; an inner panel (intermediate pocket) coupled to a second side (or inner side) of the front cover to form a pocket; a back cover, a spine interconnecting the front cover and the back cover by hinges; wherein the inner panel includes an opening.

However, Karten et al does not disclose: a plurality of rings positioned on the spine: wherein the transparent window is flush with the front cover; wherein the spine includes a convex main body having a first flange coupled to the first hinge and a second flange coupled to the second hinge.

Abbott discloses in Fig. 2, a binder comprising a spine having a plurality of rings; and wherein the transparent window is flush with the front cover.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Karten et al's binder with a plurality of rings on the binder as taught by Abbott for providing a means in which to bind additional loose leaf sheets.

However, Karten et al as modified by Abbott does not disclose: wherein the spine includes a convex main body having a first flange coupled to the first hinge and a second flange coupled to the second hinge.

Arakaki discloses in Fig. 2 and in attachment I, a spine having a convex main body (44), and a first flange (68a) coupled to the first hinge (68); and a

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second flange (68b) coupled to second hinge (68, on opposite edge of spine (50).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Karten et al's and Abbott's binder with a spine having hinged flanges as taught by Arakaki for providing a means in which to remove the front for personalization.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-11, 17, 18, and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arakaki in view of Ong (6,854,915) and further in view of Rigolini (3,617,074).

Arakaki discloses a binder comprising: a front cover (12) having an opening (see Fig. 2-4); an outer panel (14) positioned with the opening; an inner panel (70) coupled to the second side of the cover (18); a back cover (28); a spine

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comprising a convex main body and a first flange (68a) coupled to the first hinge (68); and a second flange (68b) coupled to second hinge (68, on opposite edge of spine (50); wherein the main spine body includes indentations (48).

However, Arakaki does not disclose having a plurality of rings positioned within the main body of the spine; wherein the inner panel includes a slot; a means for coupling an inner panel and the transparent window to the second side of the front cover; wherein the transparent window is made out of polycarbonate material. Arakaki also does not disclose a flange extending from the spine.

Ong discloses in Fig. 1 and 2, a binder comprising: a plurality of rings positioned on the spine; wherein the inner panel (50) includes slots (54); and a heat sealing means (Col. 4, lines 53-65) for coupling an inner panel and the transparent window to the second side of the front cover (as seen in Fig. 2).

Rigolini teaches a binder having front cover (4), rear cover (6), a spine interconnecting the two and two flanges (111) extending from and coextensive with the spine and a hinge (112) connecting the spine and the flange, the front as well as the rear covers being attached to the flange ('074, figures 1, 2, 5 and col. 3, lines 37-65).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Arakaki's binder with a ring mechanism on the spine, and a means for coupling the window and the inner panel to the second side of the front cover as taught by Ong for providing an alternate means in which to store and secure items in a cover pocket. It would

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have also been obvious to one having ordinary skill in the art at the time the invention was made to modify Arakaki's binder such that it has a flange extending from and coextensive with its spine as taught by Rigolini for the purpose of having a binder that can withstand repeated flexing and abuse ('074, col. 3, lines 61-65).

In regards to **Claims 10 and 22**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the transparent window in any desirable type of material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Therefore, it would have been obvious to construct the transparent window cover with any desired material, since applicant has not disclosed in the specification or drawings the criticality of using a particular material, and invention would function equally as well with any desired material.

3. Claims 1, 2, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arakaki in view of Abbott and further in view of Rigolini (3,617,074).

Arakaki discloses a binder comprising: a front cover (12) having an opening (see Fig. 2-4); an outer panel (14) positioned with the opening; an inner

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panel 70) coupled to the second side of the cover (18); a back cover (28); a spine comprising a convex main body and a first flange (68a) coupled to the first hinge (68); and a second flange (68b) coupled to second hinge (68, on opposite edge of spine (50).

However, Arakaki does not disclose having a plurality of rings positioned within the main body of the spine; wherein the outer panel is flush with the front cover. Arakaki also does not disclose a flange extending from the spine.

Abbott discloses in Fig. 4, a binder comprising a plurality of rings on the main body of the spine; and wherein the outer panel (30) is flush with the front cover (100).

Rigolini teaches a binder having front cover (4), rear cover (6), a spine interconnecting the two and two flanges (111) extending from and coextensive with the spine and a hinge (112) connecting the spine and the flange, the front as well as the rear covers being attached to the flange ('074, figures 1, 2, 5 and col. 3, lines 37-65).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Arakaki's binder with a flush outer panel as taught by Abbott for providing cover having a window with an even surface. It would have also been obvious to one having ordinary skill in the art at the time the invention was made to modify Arakaki's binder such that it has a flange extending from and coextensive with its spine as taught by Rigolini for the



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purpose of having a binder that can withstand repeated flexing and abuse ('074, col. 3, lines 61-65).

### ***Allowable Subject Matter***

4. Claims 13-16, and 19-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Frank, Feder, Drysdale and Cooper et al. disclose binders with flanges connecting the front and rear cover with the spine.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

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See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Addisu at (571) 272-6082. The examiner can normally be reached on 8:30 am - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

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SA  
8/31/07

  
MONICA CARTER  
SUPERVISORY PATENT EXAMINER